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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,197	02/10/2005	Jose Ignacio Andres-Gil	JANS-0075 (JAB1721USPCT)	4118
45511 7590 07/30/2007 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER LEESER, ERICH A	
			ART UNIT 1624	PAPER NUMBER
			MAIL DATE 07/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,197	Applicant(s) ANDRES-GIL ET AL.	
	Examiner Erich A. Leeser	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10 and 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 4, 6, 7, 9 and 11 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Interview Summary	Application No.	Applicant(s)	
	10/524,197	ANDRES-GIL ET AL.	
	Examiner	Art Unit	
	Erich A. Leeser	1624	

All participants (applicant, applicant's representative, PTO personnel):

(1) Erich A. Leeser. (3) _____

(2) Maurice Valla. (4) _____

Date of Interview: 19 July 2007.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____

Claim(s) discussed: 9 and 11.

Identification of prior art discussed: _____

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: A telephone call was made to Maurice Valla on July 19, 2007 and he gave authorization to Examiner to include composition claims 9 and 11 in with elected Group I for examination.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

DETAILED ACTION

Election/Restriction

1. Claims 1-11 and 13-16 are currently pending. In correspondence dated June 18, 2007, Applicant elected with traverse the invention of Group I directed to claims 1-7 and drawn to various c-substituted tricyclic isoxazoline derivative compounds.

While Applicant is correct that the particular compound presented in the Restriction Requirement does not read on the instant claims due to the proviso statement of the instant claims, at least two other compounds of the reference does in fact anticipate the instant elected claims of Group I.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-7, 9 and 11 are examined. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

A telephone call was made to Maurice Valla on July 19, 2007 and he gave authorization to Examiner to include composition claims 9 and 11 in with elected Group I for examination.

Priority

2. Acknowledgment is made that this application is a 371 of PCT/EP03/50374, filed on August 12, 2003 and claims benefit of EPO 02078322.1, filed on August 12, 2002.

Information Disclosure Statement

3. The references disclosed in the IDS dated February 10, 2005 are made of record.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-7, 9 and 11 are rejected under 35 USC 102(b) as being anticipated by Andres-Gil, et al., U.S. Patent No. 7,169,786 (this is the U.S. version of the same reference cited in the Restriction Requirement). The reference teaches isoxazoline derivative compounds, which include instant compounds. Specifically, the compounds 216 found in column 101 and 349 found in column 103 of the reference anticipates the aforementioned claims when R¹ is phenyl, R² is hydrogen, R³ is phenyl, R⁴ is hydrogen, m is one, X is oxygen and Pir is piperazine in the case of compound 216 and R¹ is methoxy, R² is phenyl, R³ is phenyl, R⁴ is methyl, m is one, X is oxygen and Pir is piperazine in the case of compound 349.

In addition, Andres-Gil teaches compositions made from his taught compounds throughout the patent, including his claims 5 and 7 which anticipate instant claims 9 and 11. Therefore, the instant claims 1-7, 9 and 11 are anticipated by Andres-Gil, et al., U.S. Patent No. 7,169,786.

Claim Objections

5. Claim 5 is objected to as being dependent upon rejected independent claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 6-7, 9 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 7-9 and 12 of Andres-Gil, et al., copending application 10/510,220. The reference and the instant application are obvious variants over one another because, for instance, compound 103 on page 31 of the reference is identical to compound 25 on page 42 of the instant specification. Because the specification of the reference specifically teaches that the compounds of formula (I) have the

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identical use, one of ordinary skill would clearly find the subject matter of the instant claims to be obvious in view of the claims of the co-pending application.

This obviousness-type double patenting rejection is provisional because the conflicting claims have not in fact been patented.

Claims 1-3, 6-7, 9 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6-7, 9 and 11 of Andres-Gil, et al., copending application 10/524,989. There is significant overlap between the structure of the compounds of the instant claims and those taught by the reference when both R¹⁴ and R¹⁵ of the reference are hydrogen. Because the specification of the reference specifically teaches that the compounds of formula (I) have the identical use, one of ordinary skill would clearly find the subject matter of the instant claims to be obvious in view of the claims of the co-pending application.

This obviousness-type double patenting rejection is provisional because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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